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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965.

No. 612

M. B. SKINNER COMPANY,
Petitioner,

vs.

CONTINENTAL INDUSTRIES, INC.,
Respondent.

PETITION FOR REHEARING OF ORDER DENYING PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT.

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THE BUNTHORP-WARREN PRINTING COMPANY, CHICAGO

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Petitioner respectfully requests a rehearing of its Petition for a Writ of Certiorari denied by this Court. 34 U. S. L. Week 3304 (U. S. March 7, 1966).

This is a patent infringement case wherein petitioner contends that the court of appeals and the district court failed to apply the correct standard of patentability as set forth in 35 U. S. C. § 103.

Subsequent to the filing of the petitioner for writ of certiorari here, the same court of appeals decided *King-Seeley Thermos* v. *Refrigerated Dispensers,* 354 F. 2d 533 (10th Cir. 1965), in which the standard of patentability

there applied was in direct and irreconcilable conflict with the standard applied by that court in the instant case. More important, the decision below in the instant case is also in direct and irreconcilable conflict with this Court's recent decision in *Graham* v. *John Deere Co.*, 34 U. S. L. Week 4119 (U. S. February 21, 1966). These conflicts did not exist and could not be anticipated when the Petition for Writ of Certiorari was filed on September 24, 1966.

In setting forth its interpretation of the standard of patentability in the instant case, the court of appeals said:[1]

> "Appellant's claims of invention therefore are based upon what is said to be a new combination of elements, and since it is a combination of old elements appellant must show both that it accomplishes *a new and useful result and is inventive. Williams Iron Works Co.* v. *Hughes Tool Co.*, 10 Cir., 109 F. 2nd 500. . . . The standards of originality necessary to sustain a patent based upon a combination of old elements are properly burdensome. *Ditto, Inc.* v. *Minnesota Mining & Mfg. Co.*, 8 Cir., 336 F. 2d 67; *John Deere Co.* v. *Graham*, 8 Cir., 333 F. 2d 529, cert. granted, 379 U. S. 956." (Emphasis added.)

In *King-Seeley*, decided December 27, 1965, another panel of the same Circuit said at 354 F.2d 536-7:

> "A combination of various elements already known to the art is patentable if it accomplishes *either a new or an old result* 'in a more facile, economical and efficient way in a particular environment which presented peculiar and difficult problems.' " (Emphasis added.)

Since the filing of the petition for writ of certiorari in the instant case and the later contrary decision of the Tenth Circuit in *King-Seeley*, this Court considered three cases

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1. 346 F. 2d 170 at 173-4.

involving the standard of patentability under 35 U. S. C. § 103[2] and delivered its decision on February 21, 1966.[3]

In *Graham* v. *John Deere Co.*, 34 U. S. L. Week at 4119, this Court said:

> "In 1955, the Fifth Circuit had held the patent valid under its rule that when a combination produces an 'old result in a cheaper and otherwise more advantageous way,' it is patentable. *Jeoffroy Mfg., Inc.* v. *Graham*, 219 F. 2d 511, cert. denied, 350 U. S. 826. In 1964, the Eighth Circuit held, in the case at bar, that there was no new result in the patented combination and that the patent was, therefore, not valid. 333 F. 2d 529, reversing 216 F. Supp. 272. We granted certiorari, 379 U. S. 956. *Although we have determined that neither Circuit applied the correct test,* we conclude that the patent is invalid under § 103 and, therefore, we affirm the judgment of the Eighth Circuit." (Emphasis added.)

As elicited by this Court, "patentability is dependent upon three explicit conditions: novelty and utility as articulated and defined in § 101 and § 102, and non-obviousness, the new statutory formulation, as set out in § 103." 34 U. S. L. Week 4121.

A standard of patentability requiring a new *result,* such as that enunciated below, is entirely inconsistent with the Tenth Circuit's later decision in *King-Seeley,* and with this Court's decision in *John Deere.*

Instead of directing itself to the question of whether the subject matter of the combination was novel, useful and unobvious, the Tenth Circuit here said it must be shown that the combination "accomplishes a new and useful *result* and is inventive." (Emphasis added.)

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2. *Graham* v. *John Deere; Calmar* v. *Cook Chemical Co.;* and *United States* v. *Adams.*

3. Reported at 34 U. S. L. Week 4119-35.

In *Graham* v. *John Deere*, 34 U. S. L. Week at 4122, this Court said:

> "... Congress has emphasized 'non-obviousness' as the operative test of the section, rather than the less definite 'invention' language of *Hotchkiss* that Congress thought had led to 'a large variety' of expressions in decisions and writings. In the title itself, the Congress used the phrase 'Conditions for patentability: *non-obvious subject matter,*' thus focusing upon 'non-obviousness' rather than 'invention'. The Senate and House Reports, S. Rep. No. 1979, 82d Cong., 2d Sess. (1952); H. R. Rep. No. 1923, 82d Cong., 2d Sess. (1952), reflect this emphasis in these terms."

The district court in its findings (adopted verbatim from respondent) never mentioned § 103 nor did it focus on the standard of non-obviousness as recently defined by this Court.

Specifically, the pertinent district court findings recite that appellant's device produced "no unobvious *results* and would be within the ordinary skill of the art",[4] "produces no new or unobvious *result* to a worker ordinarily skilled in the prior art",[5] "produces no new or unobvious *result* that would not be suggested to a worker skilled in the art",[6] and "produces no unobvious *results* and would be within the ordinary skill of the art."[7]

Thus, these findings clearly reflect an erroneous test of patentability, *i.e.*, whether the *results* were unobvious rather than whether the *subject matter of the combination was unobvious* as required by section 103 and the authority of this Court's recent decisions.

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4. Findings of Fact 11, Petn. 31.
5. Findings of Fact 12, Petn. 31.
6. Findings of Fact 13, Petn. 31-32.
7. Findings of Fact 24, Petn. 35.

It is well established that the denial of a writ of certiorari is not an affirmance by this Court of the decision below. *Brown* v. *Allen,* 344 U. S. 443 (1953). With that fact in mind, petitioner filed a Petition for Rehearing *En Banc* in the Tenth Circuit on March 16, 1966 (eight days subsequent to this Court's denial of the Petition for Writ of Certiorari) seeking to have the court of appeals resolve the conflict between its decision in the instant case, the *King-Seeley* case, and *Graham* v. *John Deere.* Petitioner is now awaiting the decision of the court of appeals.

Under Rule 58 of the Supreme Court, an unsuccessful petitioner for writ of certiorari has 25 days from denial of the petition to seek a rehearing. The facts being what they are, petitioner finds itself all dressed up with a meritorious and just argument but with no place to go if the court of appeals denies the Petition for Rehearing *En Banc* after 25 days have passed from the denial of the writ. Petitioner will be denied due process of law, since it was not afforded a proper hearing wherein the controlling rule of law was correctly applied.

Petitioner respectfully prays for an order either: (a) granting its petition for writ of certiorari, (b) remanding the case to the court of appeals for hearing in accordance with this Court's controlling decision in *Graham* v. *John Deere,* or (c) holding the present petition for rehearing in abeyance until there is a disposition by the court of appeals, and if that disposition be adverse to petitioner, granting petitioner leave to file a new or supplemental petition for writ of certiorari or petition for rehearing.

Petitioner is mindful of the unusual nature of its prayer but submits that it is justified by the unusual nature of the facts involved.

Respectfully submitted,

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CERTIFICATE.

Norman M. Shapiro certifies that the foregoing Petition is presented in good faith and not for delay and is restricted to the grounds specified in Rule 58 of the Rules of this Court.

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